

Application Serial No. 10/570,739  
Reply to Office Action of January 30, 2009

PATENT  
Docket: CU-4717

## REMARKS

In the Office Action, dated January 30, 2009, the Examiner states that Claims 2-4 are pending, Claim 4 is withdrawn, and Claims 2-3 are rejected. By the present Amendment, Applicant cancels Claims 2-4 and adds new Claims 5-8.

### Rejection under 35 U.S.C. §103(a)

Claims 2 and 3 are rejected as obvious over Handforth (US 4,402,262) in view of Schnee et al. (US 3,936,547). Applicant respectfully disagrees with and traverses this rejection.

At the outset, Applicant indicates that the claims have been cancelled and new Claims 5-8 have been added. New Claims 5-7 are based on the original claims 1 and 2. Support for new Claim 8 can be found, for example, in paragraphs [0029] – [0030] of the present specification. Further, the feature regarding the type of water-based resin recited in Claims 5 and 8 is based on paragraph [0020] of the present specification.

The decorative paper exhibiting brightness recited in Claim 5 (present invention) comprises a casein resin in its bright ink layer. As the casein resin is a material excellent in heat resistance, the bright ink layer of the decorative paper exhibiting brightness of the present invention can be made excellent in heat resistance. Further, by making the bright ink layer excellent in heat resistance, the following advantageous effects can be attained:

The decorative paper exhibiting brightness of the present invention is to be used for a thermosetting decorative sheet. Normally, the thermosetting decorative sheet comprises an adherend in addition to the decorative paper. In the technical field of manufacturing such a thermosetting decorative sheet, a thermal pressure molding, in which a decorative paper impregnated with a thermosetting resin and an adherend are laminated and then thermally pressured, is generally employed (paragraphs [0030] – [0032] of 2007/0036984).

As the heat is also applied to a bright ink layer itself at the time of thermal molding, when a heat resistance of the bright ink layer is low, surface irregularity in the brightness occurs to the thermal molded bright ink layer.

The bright ink layer of the present invention can avoid this because it contains the casein resin and is excellent in heat resistance so that surface irregularity in the brightness can be reduced even if an adherend is laminated on the decorative paper

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exhibiting brightness by a thermal pressure molding.

In contrast thereto, although Handforth discloses a decorative paper containing two components of an acrylic resin and a urethane resin, it is completely silent in terms of a casein resin. Accordingly, when the decorative paper of Handforth is impregnated with the melamine resin of Schnee et al. to make a thermosetting decorative sheet, unlike the present invention, the obtained decorative sheet cannot be one with little surface irregularity because the ink layer used for the decorative paper does not have heat resistance.

To support a *prima facie* case of obviousness, the Office Action must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007).

Applicant respectfully asserts that as Handforth is silent regarding the feature of casein resin, a *prima facie* case of obviousness cannot presently be established. Accordingly, Applicant respectfully asserts that new Claims 5 and 8 should not be rejected as obvious over Handforth in view of Schnee et al.

Since independent Claims 5 and 8 are allowable over the prior art, Applicant asserts that all claims depending therefrom are allowable for at least the same reasons, as well as for the features that they recite.

In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

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